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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,734	08/06/1999	TOMMY PETROGIANNIS	9740-006	7187
20583	7590	04/14/2004	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			GURSHMAN, GRIGORY	
			ART UNIT	PAPER NUMBER
			2132	16
DATE MAILED: 04/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/369,734	PETROGIANNIS, TOMMY
Examiner	Art Unit	
Grigory Gurshman	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 16 March 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-46 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-46 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's amendment of claims 1, 13, 21, 33 and 40 reflects "user approving the electronic document by generating approval information". This limitation is taught by Ray as stated in the rejection herein. Applicant states that generating approval information is an external, positive act that the user performs. Examiner agrees with this statement, but points out that this feature does not clearly distinguish Applicant's invention from Ray, since this feature is taught by Ray.
2. Referring to the rejection of claims 1-46, Applicant continues to argue that the primary reference Ray (U.S. Patent No. 5,673,320) is not applicable to the present invention. Applicant argues that examiner concludes that the conversion of the information on the printed document into a storable image results in an electronic document while this conversion does not result in an electronic document in the context of the present application. Examiner respectfully disagrees and points out that Ray teaches converting information of a printed document into a storable *digital image* thereby creating an electronic document (see abstract and Fig. 2). The reader (unit 22 in Fig. 2) reads the document and converts the image information into digital image format, which is stored in a data storage (unit 24). The digital image data is encrypted and the encoded authorization data is formulated for the document (see abstract and column 2 lines 60 - 68). Therefore Ray does teach the use of electronic document as claimed by Applicant.

3. Applicant also argues that Ray does not teach the parallel approval of an electronic document. Examiner agrees, but points out that parallel approval of a document is only included in preamble, but not reflected in the claims.

3. Applicant further argues that Ray teaches away from claimed invention since the abstract and Fig. 2 do not state that the electronic document is created. Examiner disagrees and points out that Ray teaches that image information is converted into a storable image (see abstract). The conversion process is shown in Fig. 2. A storable image is an electronic file (for example jpeg, bitmap or tiff format). One of ordinary skill in the art would have equated an image file with an electronic document. The mere fact that the electronic image is derived from a paper document does not make it different from any other electronic document created using different method. Ray does teach approving the electronic document. Therefore Ray does not by any means teach away from the claimed invention.

4. Applicant points out that there are some differences between DAC and IVV of Ray. Examiner agrees but points out that both DAC and IVV are some authentication/validation values derived from an electronic document. DAC and IVV are used for the exact same purpose. One of ordinary skill in the art would have equated DAC as claimed by Applicant with IVV of Ray.

5. Referring to the instant claims, Applicant argues that secondary references Kazmierczak, Kurata, Jakubowski, and Shkedy do not correct the deficiencies of Ray. Examiner respectfully disagrees and points out that Ray the combination of the above references with Ray renders the Applicant's claims obvious as stated in the instant

Office Action. The reasons for the combination and motivations are provided in 35 USC § 103 rejections below.

6. Applicant further argues the motivation to combine Ray with Kazmierczak, stating that the motivation is not relevant to the claimed invention since the present invention is not directed to making the purchases. Examiner points out that motivation to combine the references can be different from the Applicant's motivation. In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have been motivated to store the approval Data Authentication Code in an Approval Data Packet for creating a flexible system in which a purchaser is granted permission to purchase data on line in real time (see Kazmierczak, abstract).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 9, 12, 13, 17, 20, 21, 29, 32, 33, 35, 36, 39, 40, 43 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray (U.S. Patent No. 5.673.320) in view of Kazmierczak (U.S. Patent No. 5.764.762).

9. Referring to the instant claims, Ray discloses a method for image based validation of a document (see abstract). Ray teaches converting information of a printed document into a storable digital image thereby creating an electronic document (see abstract and Fig 2). The reader (unit 22 in Fig 2) reads the document and converts the image information into digital image format, which is stored in a data storage (unit 24). The digital image data is encrypted and the encoded authorization data is formulated for the document (see abstract and column 2 lines 60 - 68). The limitation "generating an original Data Authentication Code (DAC 0) linked to the electronic document" is met by generation of an image-validation-value (see column 6 lines 25 – 30). The limitation "making the electronic document available to each user" is met by units 54 and 56 in Fig 4, showing that the document is issued and presented to a user. The limitation "retrieving DAC 0" is met by generation of an image-validation-value (see column 6 lines 25 – 30). The document validation value is compared with the stored document validation value of a selected document (see column 10 lines 55 - 65), which meets the limitation "comparing DAC x to DAC 0". The limitation "user ... generating an approval information" is met by an approval code (column 10, lines 57-58).

An approval code is produced (see column 10, line 58), which also meets "an approval Data Authentication Code", recited in the instant claims. Ray however does not

explicitly teach storing approval information in a user Approval Data Packet. Kazmierczak discloses encrypted data package record for use in remote transaction data system (see abstract). Kazmierczak teaches the use of Message Authentication Codes (MACs) calculated by assembling the insecure header data with encrypted header data (see column 6 lines 45 - 55). Kazmierczak teaches approving the record and creating the secure header packet (see column 6 lines 55-60), which meets the Approval Data Packet recited in the instant claims. The MAC is stored as a part of a secure header packet. Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to produce an approval Data Authentication Code of Ray and store it in an Approval Data Packet as taught in Kazmierczak. One of ordinary skill in the art would have been motivated to store the approval Data Authentication Code in an Approval Data Packet for creating a flexible system in which a purchaser is granted permission to purchase data on line in real time (see Kazmierczak, abstract).

10. Referring to claims 12, 20, 32, 39 and 46, Ray teaches that authentication code contains the date and the time of the presentation of the document (see column 6, lines 27-30).

11. Claims 2 - 6, 14, 22, 23, 24, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray (U.S. Patent No. 5,673,320) in view of Kazmierczak (U.S. Patent No. 5,764,762) and further in view of Kurata (JP 403004361A).

12. Referring to the instant claims, Ray and Kazmierczak teach generating an approval information and storing it in a user Approval Data Packet (ADPx). Ray and

Kazmierczak however do not explicitly teach incorporating the approval information from each ADPx into the electronic document. Kurata teaches comparing an input name with the registered name and thereby producing an approval code (see abstract). The approval code is entered in a prescribed area of a document (see Constitution). Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to generate an approval information and store it in a user Approval Data Packet (ADPx) of Ray and Kazmierczak and incorporate the approval information into the electronic document as taught in Kurata. One of ordinary skill in the art would have been motivated to generate an approval information and store it in a user Approval Data Packet (ADPx) and incorporate the approval information from each ADPx into the electronic document for added security of approval processing (see Kurata, constitution).

13. Claims 7, 8, 15, 16, 27, 28, 34, 35, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray (U.S. Patent No. 5.673.320) in view of Kazmierczak (U.S. Patent No. 5.764.762) and further in view of Jakubowski (U.S. Patent No. 6.128.737).

14. Referring to the instant claims, Ray and Kazmierczak teach generating Data Authentication Code (DAC) linked to the electronic document. Ray and Kazmierczak however do not explicitly teach encrypting DAC. Jakubowski teaches the use of message authentication code (MAC). Jakubowski also teaches encrypting MAC and inserting it into predefined portion of a message (see abstract). Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to

generated DAC linked to the electronic document of Ray and Kazmierczak and encrypt DAC as taught in Jakubowski. One of ordinary skill in the art would have been motivated to generate DAC linked to the electronic document and encrypt DAC for assuring integrity of a ciphertext message (see Jakubowski, abstract).

15. Claims 10, 11, 18, 19, 30, 31, 37, 38, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray (U.S. Patent No. 5.673.320) in view of Kazmierczak (U.S. Patent No. 5.764.762) and further in view of Shkedy (U.S. Patent No. 6.236.972 B1).

16. Referring to the instant claims, Ray and Kazmierczak teach approving the electronic document and storing approval information. Ray and Kazmierczak however do not explicitly teach approval information in a form of user signature or user biometric information. Shkedy teaches the use of digital signatures and biometric means for authentication of customer's identification (see column 5, lines 3 - 7). Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to approve the electronic document of Ray and Kazmierczak using approval information in a form of user signature or user biometric information as taught in Shkedy. One of ordinary skill in the art would have been motivated to approve the electronic document using approval information in a form of user signature or user biometric information for ability to compare customer's identification with a customer identification stored in the database (see Shkedy, column 4, line 66 to column 5 line 3).

***Conclusion***

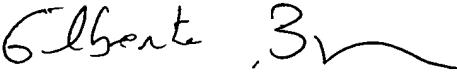
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grigory Gurshman whose telephone number is (703) 306-2900. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Grigory Gurshman  
Examiner  
Art Unit 2132

  
GG  
April 5, 2004

  
Gilberto Barron  
GILBERTO BARRON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100